

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Robert Louis Cobene II	§	Group Art Unit:	1791
		§		
Serial No.:	10/621,489	§	Confirmation No.:	2048
		§		
Filed:	07/18/2003	§	Examiner:	John L. Goff II
		§		
For:	BOOKBINDING	§	Atty. Dkt. No.:	100110643-1
	ADHESIVE FORMING	§		(HPC.0662US)
	DEVICE AND METHOD	§		
		§		

Mail Stop Appeal Brief-Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

The following sets forth Appellant's Reply to the Examiner's Answer dated January 23, 2009.

A. REPLY TO EXAMINER'S ANSWER REGARDING CLAIMS 26-28 OVER MORISHIGE, BOSS, AND CAPRIZ OR COLBERT

The Response to Arguments section of the Examiner's Answer stated that "[i]t is not clear what is meant by 'the Examiner apparently retracts earlier admissions of record'." Examiner's Answer at 11. The admission made earlier by the Examiner is the following: "Morishige does not specifically teach the cooling is performed by an active heat sink attached to an in thermal communication with at least one of the first and second contacting surfaces, i.e., clamping jaws." 12/14/2007 Office Action at 4. That admission did not appear in the Final Office Action dated June 18, 2008, but instead was replaced with the following assertion by the Examiner:

Morishige teaches the hot melt adhesive of the backed hot melt adhesive sheet is heated and melted considered heated to a temperature above the glass transition temperature of the hot melt adhesive and then actively cooled to solidify the hot melt adhesive considered actively withdrawing heat from the backed hot melt adhesive sheet to bring a temperature of a hot melt adhesive of the backed hot melt adhesive sheet from above a glass transition temperature of the hot melt adhesive to below the glass transition temperature of the adhesive. 6/18/2008 Office Action at 3.

As noted in the Appeal Brief, it is clear that Morishige fails to disclose “actively withdrawing heat from the backed hot melt adhesive sheet using a heat sink based on an active cooling device, which is one of a Peltier device, a device having an internal circulating medium, and a device based on a Joule-Thomson effect,” to bring a temperature of the hot melt adhesive from above a glass transition temperature to below the glass transition temperature of the hot melt adhesive. This feature is also missing from Boss, which discloses use of a **passive** heat sink 30 that is formed of a “relatively large thermal mass.” Boss, ¶ [0017]. Boss also notes that heat may be dissipated actively through a convection heat sink in which **moving air is used to cool** heated platen 28. *Id.* Morishige also notes that paste 112 is solidified by spontaneous cooling or forced cooling using an unshown cooling means such as a **fan**. Morishige, 6:49-52. Thus, the two primary references relied upon by the Examiner, Morishige and Boss, both disclose use of a cooling device that is based on either a passive mechanism (*e.g.*, thermal mass of Boss) or a cooling device in which cooling is achieved by convection using moving air. Neither of these solutions provide any hint of an active cooling device that is one of a Peltier device, a device having an internal circulating medium, and a device based on a Joule-Thomson effect.

A person of ordinary skill in the art would have been led by Morishige and Boss to use a mechanism that is based on passive cooling or cooling using moving air, and thus, this person of ordinary skill in the art would not have been prompted to incorporate the cooling devices of Capriz or Colbert into the hypothetical Morishige-Boss system.

Moreover, another significant error made by the Examiner is that the hypothetical combination of Morishige, Boss, and Capriz or Colbert does not provide any teaching or hint of the following subject matter of claim 26: “applying force with at least a translatable second contacting surface to the planar surface in an area where the backed hot melt adhesive sheet contacts the planar surface.” Note that the “planar surface” of claim 26 is perpendicular to the spine surface of claim 26, as expressly recited. Morishige teaches provision of an adhesive agent 112 “at the inside of the spine.” Morishige, 5:65-68. As stated by Morishige, the spine of the covering material is the bottom of the covering material, and the adhesive agent is provided on this bottom (spine). *Id.*, 1:13-15. Fig. 2A of Morishige expressly shows the covering material 8 that has a solid adhesive agent 9 “at its bottom.” *Id.*, 3:40-41.

Thus, contrary to the assertion by the Examiner, Morishige does not disclose or hint at “applying force with at least a translatable second contacting surface to the planar surface in an area where the **backed hot melt adhesive sheet** contacts the planar surface (which is **perpendicular to the spine surface of the assembly of plural sheets**).” The secondary reference, Boss, also does not provide any teaching or hint of this feature of claim 26. Fig. 2 of Boss shows a heated platen 28 and a heat sink 30 that can be moved downwardly to engage a binding region 12 on each sheet that is to be bound to other sheets. Boss, ¶ [0016]. The binding region of each media sheet in Boss allows the sheet to be bound to another previously bound sheet using an imaging material as the binding material. *Id.*, ¶ [0015]. In Boss, a backed hot melt adhesive sheet that is distinct from the assembly of plural sheets, as recited in claim 26, is clearly not disclosed. Therefore, Boss also does not provide any teaching or hint of the claimed feature that is noted above as missing from Morishige.

Moreover, Colbert and Capriz were cited by the Examiner as disclosing particular types of heat sinks – however, these references provide absolutely no hint whatsoever of the “applying” element of claim 26.

In view of the foregoing, it is respectfully submitted that even if the references could be hypothetically combined, their hypothetical teaching would not have led to the claimed subject matter.

Therefore, for the foregoing reasons as well as reasons stated in the Appeal Brief, the obviousness rejection of claim 26 and its dependent claims is clearly erroneous.

B. REPLY TO EXAMINER’S ANSWER REGARDING CLAIMS 26-28 OVER YAMANAKA, BOSS, CLARK, AND CAPRIZ OR COLBERT

In the Examiner’s Answer, the Examiner argued that the arguments presented by the Appellant over rejections based on Yamanaka “are substantially the same as Morishige.” As conceded by the Examiner, Yamanaka is completely silent in using any type of cooling device. As discussed above, the secondary reference, Boss, that is relied upon by the Examiner, also does not provide any teaching or hint of using an active cooling device as recited in claim 26. Boss discloses the use of a passive heat sink or a heat sink that relies upon moving air for conduction-based cooling. Neither of these references provide any teaching or hint of the active cooling device that is specifically recited in claim 26.

In view of the fact that the two main references (Yamanaka and Boss) relied upon by the Examiner provides no teaching or hint of the cooling device used in the context of claim 26, it is respectfully submitted that the obviousness rejection based on Yamanaka, Boss, Clark, and Capriz or Colbert is improper. In fact, it is submitted that what the Examiner has engaged in is to use impermissible hindsight to piece together un-related elements of prior art references to

achieve the claimed subject matter, where the cited references actually would have led a person of ordinary skill in the art away from using the claimed combination.

In view of the foregoing, the obviousness rejection of claim 26 and its dependent claims over Yamanaka, Boss, Clark, and Capriz or Colbert is clearly erroneous.

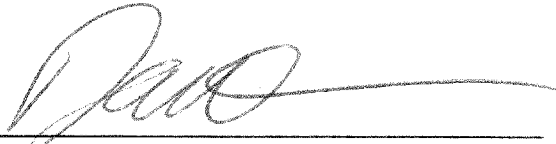
C. CONCLUSION

In view of the foregoing, and in view of the arguments presented in the Appeal Brief, allowance of all claims is respectfully requested.

Respectfully submitted,

Date: _____

Mar 23, 2009



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